

REMARKS

Claims 9-14, 16-37, and 40 are pending. Claims 1-8, 15, 38, and 39 were previously canceled. Claims 9-14 and 24-37 were previously withdrawn from consideration. Claims 16 - 18, 21, and 40 are currently amended. Reconsideration of the application is requested.

Applicant thanks the Examiner for the courtesies extended to applicant's representative, Sandra K. Nowak, during the November 25, 2008 telephonic interview. Applicant's Interview Summary is being filed concurrently herewith.

§ 102 Rejections

Claims 16-23 and 40 are rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,657,162 to Nilsen et al. ("Nilsen"). Specifically, the Examiner asserts that "Nilson discloses a compound substrate comprising a first substrate having a structured surface, a second substrate piece and/or discrete pieces embedded in a portion of the structured surface of the first substrate and at least one cube corner element that has at least one constituent face disposed on the first substrate and a[t] least another constituent face disposed on the second substrate piece. Each of the first and second substrate have an exposed surface that defines a face of a cube corner element on the compound substrate" (Office Action, pages 2-3 (citations omitted)). Applicant respectfully traverses the Examiner's rejection. Further, applicant disagrees with the Examiner's assertion that the product as claimed is not structurally different from the product of Nilsen.

The Examiner states that "[t]he limitation 'wherein embedding the second substrate piece in the structure surface of the first substrate involves. . . ' is a method limitation and does not determine the patentability of the product" and "[t]he resulting structure from this method is that embedding the second substrate piece only requires that the second substrate piece to be bonded to the first substrate at certain points" (Office Action, page 3). Applicant disagrees with the Examiner's characterization of the claim term "embed." The word "embed" is defined by The American Heritage® Dictionary of the English Language (Fourth Edition 2000) as "[t]o fix firmly in a surrounding mass" (copy attached). Nilsen neither describes nor shows metallic deposits that are fixed firmly in a surrounding mass. Instead, Nilsen only shows at FIG. 2 and describes

at col. 2, lines 64-65 forming "transparent reflective metallic deposits on the surface of the microprism formations" (emphasis added). As such, Nilsen does not teach, describe, or suggest the elements of independent claims 16, 20, and 40 as amended or of their respective dependent claims.

Further, claims 17, 18, and 40 recite "a transition line." As is defined in the specification, a transition line is defined as "a line or other elongated feature that separates constituent faces of a compound face" (page 28, lines 25-26). Compound face and constituent face are defined, respectively, as "a face composed of at least two distinguishable faces (referred to as "constituent faces") that are proximate each other" (page 26, lines 13-14). Thus a transition line is a structural feature that is not described or suggested in Nilsen.

For at least all of these reasons, applicant believes that the rejection of claims 16-23 and 40 under 35 USC § 102(b) as being anticipated by Nilsen has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance.

Respectfully submitted,

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Date

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The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

embed

SYLLABICATION: em·bed

PRONUNCIATION:  ěm-bĕd'

VARIANT FORMS: also **im·bed** (ĩm-)

VERB: Inflected forms: **em·bed·ded**, **em·bed·ding**, **em·beds**

TRANSITIVE VERB: 1. To fix firmly in a surrounding mass: *embed a post in concrete*; *fossils embedded in shale*. 2. To enclose snugly or firmly. 3. To cause to be an integral part of a surrounding whole: "*a minor accuracy embedded in a larger untruth*" (Ian Jack, *Granta* Fall 1988). 4. *Biology* To enclose (a specimen) in a supporting material before sectioning for microscopic examination.

INTRANSITIVE VERB: To become embedded: *The harpoon struck but did not embed*.

OTHER FORMS: **em·bed'ment** —NOUN

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